



PATENT
Docket No.: 0023-0040

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Brian Gaudet) Group Art Unit: 2182
Application No.: 09/966,094 /) Examiner: K. Huynh
Filed: October 1, 2001)
For: SCALEABLE GAP INSERTION)
IN A DATA LINK)

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Technology Center 2100

PETITION UNDER 37 CFR § 1.144
TO WITHDRAW RESTRICTION REQUIREMENT

U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop Petition
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Dear Sir:

This is a petition under 37 C.F.R. § 1.144 to withdraw the restriction requirement initially issued by the Examiner in the Office Action of December 22, 2003, traversed by Applicant in the Response of January 22, 2004, and made final by the Examiner in the Office Action of March 8, 2004. In this petition, Applicant respectfully requests that at least portions of the Restriction be withdrawn.

The Restriction Requirement

The Restriction of December 22, 2003 states that the application contains claims directed to three species, shown in Figs. 4 (Species 1), 5 (Species 2), and 3 (Species 3).

The Restriction required Applicant to elect a single disclosed species for prosecution on the merits.

In the Response of January 22, 2004, Applicant grouped the claims as follows:

Species 1—claims 1-3, 5-8, 15, 16, and 19-21;

Species 2—claims 4, 6, 9-13, 17, 18, 23, and 24; and

Species 3—claims 14 and 22.

Additionally, Applicant provisionally elected to prosecute the claims of Species 1 (claims 1-3, 5-8, 15, 16, and 19-21), with traverse.

In the Office Action of March 8, 2004, the Examiner maintained the Restriction based on the rationale that “species 1 and 2 are related as combination and subcombination.” (Office Action of March 8, 2004, numbered paragraph 2). Further, the Examiner effectively re-classified the groups selected by Applicant by withdrawing claims 15, 16, and 19-21 from consideration. (Id., numbered paragraph 2). The Examiner then issued a substantive response for claims 1-3 and 5-8. (Id., numbered paragraphs 3-6).

***The Restriction Requirement Is
Improper and Should be Withdrawn***

The Examiner’s initial rationale for the Restriction Requirement was that figures 4, 5, and 3 define patentably distinct species. As discussed in the Response of January 22, 2004, Applicant submits that the Examiner’s classification of Figs. 4 and 5 as defining two different species of the invention is improper, as the claims corresponding to these figures are not mutually exclusive of one another. MPEP 806.04(f) discusses this aspect of a proper species restriction as follows:

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

(MPEP 806.04(f), emphasis added). Applicant submits that the claims corresponding to Figs. 4 and 5 are not mutually exclusive. Fig. 4, for instance, includes a number of elements, including a character specific gap inserter 404. Fig. 5 is a diagram illustrating an implementation of character specific gap inserter 404 illustrated in Fig. 4. (See Spec., paragraph 41). Thus, under Applicant's disclosure, claims drawn to these two figures cannot be mutually exclusive, as Figs. 4 and 5 merely illustrate various levels of detail of the same embodiment. This is further supported by the fact that claims 4 and 6, which correspond to Fig. 5, depend from claims 1 and 3, which correspond to Fig. 4. Similarly, claims 17 and 18, which correspond to Fig. 5, depend from claim 16, which corresponds to Fig. 4.

In the latest Office Action of March 8, 2004, the Examiner now contends that Applicant's arguments are not persuasive as "species 1 and 2 are related as combination and subcombination." (Office Action of March 8, 2004, numbered paragraph 1). Applicant submits that this rationale does not make sense. Claims to be restricted to different species must be mutually exclusive. (MPEP, 806.04(f)). The concept of "mutually exclusive" is not consistent with the concept of a "combination and subcombination." See MPEP 806.03-806.04(i) for a discussion of restriction practice based on claims corresponding to Species and MPEP 806.05 for a discussion of

restriction practice based on claims corresponding to related inventions as Combination and Subcombination.

For at least these reasons, the Restriction Requirement with respect to Species Groups 1 and 2 is improper and should be reversed. Accordingly, Applicant requests that all of the claims corresponding to Species 1 and 2 be examined.

*The Examiner's Reclassification of
Claims 15, 16, and 19-21 Is Improper*

Applicant disputes the Examiner's re-classification of the claims in the Species' Groups. The Examiner, in the initial Office Action of December 22, 2003, required Applicant to elect a single disclosed Species and to list all claims readable thereon. (Office Action of December 22, 2003, numbered paragraph 1). Applicants properly did so in the Response of January 22, 2004. In the latest Office Action, however, the Examiner has arbitrarily withdrawn claims from consideration (e.g., claims 15, 16, and 19-21), even though these claims were identified as belonging to the elected Species. Applicant submits that these claims should be examined, as they correspond to the disclosure relating to Fig 4 (Species 1).

In conclusion, Applicant respectfully requests that this petition to withdraw at least a portion of the restriction requirement be granted, and the claims corresponding to Figs. 4 and 5 be examined on their respective merits.

To the extent necessary, a petition for an extension of time under 37 CFR 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

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